

REMARKS

All the pending claims were rejected as being anticipated by or, alternatively, obvious over, Kim et al, U.S. 6,071,525. Applicants respectfully traverse.

Kim teaches a method for enhancing the whitening effect of skin-care products. In contrast, Applicants claim a method for increasing the shelf life of such skin-whitening compositions. Therefore, the claimed method is not anticipated by Kim because this method is neither explicitly nor inherently described in Kim.

The Examiner's observation that Formulation 4 set forth in Table 3 of Kim contains sodium magnesium silicate does not establish anticipation under 35 U.S.C. § 102(e). The claimed invention is the *method* of preventing decomposition rather than the *composition* that would effect such a result. The mere presence of sodium magnesium silicate in a single composition containing many other components does not teach a method for inhibiting the decomposition of skin-whitening agents, absent some additional explanation about the decomposition-inhibiting effects of sodium magnesium silicate.

Further, the inclusion of sodium magnesium silicate in Formulation 4 was likely for a purpose other than inhibiting decomposition (e.g., for the common purpose of thickening the cream composition), and therefore, cannot inherently teach a method for inhibiting decomposition. This conclusion is supported by the fact that, despite the premature tendency of botanical extracts such as mulberry extract to oxidize (See page 2, paragraph 6 of Application), and the inclusion of mulberrin in every formulation in

Kim, Kim does not mention the decomposition-inhibiting effects of adding sodium magnesium silicate, nor is sodium magnesium silicate used in any other formulation set forth in the patent.

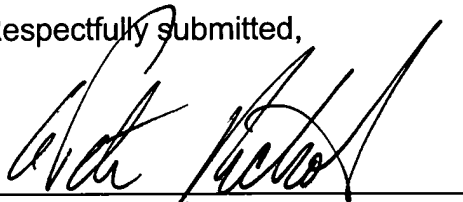
Finally, the method described in Kim requires the addition of mulberrin to the skin-care product, whereas the claimed method requires the addition of sodium magnesium silicate. Although both methods involve inhibition, they involve two entirely different types of inhibition – inhibition of tyrosinase production in human skin in Kim, and inhibition of the oxidation/decomposition of skin-whitening agents in the claimed method. Kim focuses on the need for a superior whitening agent that is safe to use in skin care products, whereas the claimed invention focuses on the need to prevent decomposition of such agents.

As for the Examiner's contention that Kim renders obvious the presently claimed method, Applicants note that Kim simply teaches the use of mulberrin as a skin-whitening agent. Kim, however, does not teach or suggest adding an effective amount of sodium magnesium silicate as an agent for inhibiting the decomposition of skin-whitening agents. The mere presence of sodium magnesium silicate, among 18 other formulation components, in Table 3, Formulation 4 of Kim would not make it obvious to one skilled in the art that sodium magnesium silicate is effective as an agent for inhibiting the decomposition of skin-whitening agents. To render the claimed method obvious, the reference must enable one skilled in the art to create a formulation with oxidation-inhibiting effects. *See Beckman Instruments, Inc. v. LKB Produkter AB*, 892

F.2d 1547, 1551 (Fed. Cir. 1989) (citing *In re Payne*, 606 F.2d 303, 314 (CCPA 1979) for the proposition that a reference is prior art only for that which the reference enables).

Applicants respectfully request withdrawal of the rejection. If, for any reason, the Examiner feels that the above remarks do not put the claims in condition for allowance, the undersigned attorney can be reached at (312) 321-4276 to resolve any remaining issues.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'G. Peter Nichols', is written over a horizontal line.

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